



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER OF PATENTS AND TRADEMARKS  
Washington, D.C. 20231  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/701,315	01/09/2001	Jeremy Carver	12243.15USWO	8757

23552 7590 08/12/2002

MERCHANT & GOULD PC  
P.O. BOX 2903  
MINNEAPOLIS, MN 55402-0903

EXAMINER
----------

BAKER, MAURIE GARCIA

ART UNIT	PAPER NUMBER
----------	--------------

1627

DATE MAILED: 08/12/2002 12

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/701,315

Applicant(s)

Carver et al

Examiner

Maurie Garcia Baker, Ph. D.

Art Unit

1627

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE ONE MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

1) ☒ Responsive to communication(s) filed on May 13, 2002

2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.

3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 35 C.D. 11; 453 O.G. 213.

## Disposition of Claims

4) ☒ Claim(s) 1-22 is/are pending in the application

4a) Of the above, claim(s) 7-17 is/are withdrawn from consideration

5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.

6) ☐ Claim(s) \_\_\_\_\_ is/are rejected.

7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.

8) ☒ Claims 1-6 and 18-22 are subject to restriction and/or election requirements.

## Application Papers

9) ☐ The specification is objected to by the Examiner.

10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are a) ☐ accepted or b) ☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.

If approved, corrected drawings are required in reply to this Office action.

12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a) ☐ All b) ☐ Some\* c) ☐ None of:

1. ☐ Certified copies of the priority documents have been received.

2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.

3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\*See the attached detailed Office action for a list of the certified copies not received.

14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

a) ☐ The translation of the foreign language provisional application has been received.

15) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

1) ☐ Notice of References Cited (PTO-892)

4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_

2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

5) ☐ Notice of Informal Patent Application (PTO-152)

3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s). \_\_\_\_\_

6) ☐ Other: \_\_\_\_\_

### DETAILED ACTION

**Please Note:** In an effort to enhance communication with our customers and reduce processing time, Group 1627 is running a Fax Response Pilot for Written Restriction Requirements. A dedicated Fax machine is in place to receive your responses. The Fax number is 703-308-4315. A Fax cover sheet is attached to this Office Action for your convenience. We encourage your participation in this Pilot program. Thank you in advance for allowing us to enhance our customer service. Please limit the use of this dedicated Fax number to responses to Written Restrictions.

1. The Amendment and Response filed May 13, 2002 (Paper No. 11) is acknowledged. Claims 18-22 were added and no claims were cancelled. Therefore, claims 1-22 are pending.
2. The election of Group I (claim 1-6), without traverse, is acknowledged. New claims 18-22 read on this group. However, an election of species is deemed necessary based on the newly added claims.
3. Please note the following from MPEP 818.02(b): Where only generic claims are first presented and prosecuted in an application in which no election of a single invention has been made, and applicant later presents species claims to more than one species of the invention, *he or she must at that time indicate an election of a single species*. Since no election has been made and the newly added claims contain different species, the following requirement is set forth.

4. To clarify the record, it is noted that newly added claims 18-22 mirror claims 8-12. However, claims 8-12 are drawn to single compounds. The invention of instant Group I is a combinatorial library, which is a collection of compounds (not a single compound); however, the new claims still represent different species of library. Note that claims 8-12 were separated into two different groups as the compounds were deemed to lack unity (see previous action). Therefore, the instant election of species is deemed proper and necessary.

5. Also, claims 7-17 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to nonelected inventions. Election was made without traverse in Paper No. 11. Thus, claims 1-6 and 18-22 are currently under consideration.

***Election/Restriction***

6. Restriction is required under 35 U.S.C. 121 and 372. This application contains the following inventions or groups of inventions which are not so linked as to form a single general inventive concept under PCT Rule 13.1.

7. As stated in the previous action, the technical feature that links all of the claims is the nucleoside peptide molecule comprising a nucleoside monomer, spacer monomer and cap monomer. The groups lack unity because the claimed molecules (and libraries thereof) are known in the art as disclosed by Lee et al. This reference was described in the previous Restriction Requirement, paragraph 7.

8. This application contains claims directed to more than one species of the generic invention for Group I (now claims 1-6 and 18-22). These species are deemed to lack unity of invention because they are not so linked as to form a single general inventive concept under PCT Rule 13.1 (see paragraphs 10-12 below).

9. Applicant is required to elect from the following patentably distinct species.

Claim 1 is generic.

Species of library

A *specific* combinatorial library should be elected, for purposes of search, showing the nucleoside monomer, spacer monomer and cap monomer and all bonds between them. It is recognized that the claimed invention is a library and not a single compound; however, the core of the library should be defined. That is, the *core structure common to all library members should be defined*.

Newly added claims 19-22 define a plurality of different species of library with respect to the moieties denoted X and R; a single selection for each of these entities should be made.

10. The species listed above do not relate to a single general inventive concept under PCT Rule 13.1 because, under PCT Rule 13.2, the species lack the same or corresponding special technical features for the following reasons.

11. PCT Rule 13.2 states that unity of invention shall be fulfilled when there is a technical relationship among those inventions involving one or more of the same or corresponding special technical features". It further defines "special technical feature" as "those technical features that define a contribution which each of the claimed inventions,

claimed as a whole, makes over the prior art". For example, unity of invention is fulfilled if:

- (a) all alternatives have a common property; **and**
- (b) (i) a common structure is present, i. e. a significant structural element is shared by all alternatives, or
- (b) (ii) in cases where the common structure can not be the unifying criterion, all alternatives belong to a recognized class of compounds in the art to which the invention pertains. (MPEP 1850).

12. In the instant case, part (a) above is not fulfilled because all claimed species of library do not have a common property (i.e. their members bind differently to receptors). Further, all of the species do not belong to a recognized class of compounds in the art to which they pertain (i.e. the members can have widely varying structures). Moreover, the claimed member compounds are known in the art, see paragraph 7 above.

For these reasons, election under these rules is proper and required.

13. Applicant is required, in reply to this action, to elect a single species to which the claims shall be restricted if no generic claim is finally held to be allowable. **The reply must also identify the claims readable on the elected species, including any claims subsequently added.** An argument that a claim is allowable or that all claims are generic is considered non-responsive unless accompanied by an election.

14. Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which are written in dependent form or otherwise include all the limitations of an allowed generic claim as provided by 37 CFR 1.141. If claims

are added after the election, applicant must indicate which are readable upon the elected species. MPEP § 809.02(a).

15. Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143). Because the above restriction/election requirement is complex, a telephone call to applicants to request an oral election was not made. See MPEP § 812.01.


16. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a petition under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

17. Applicant is also reminded that a 1 - month (not less than 30 days) shortened statutory period will be set for response when a written requirement is made without an action on the merits. This period may be extended under the provisions of 37 CFR 1.136(a). Such action will not be an "action on the merits" for purposes of the second action final program, see MPEP 809.02(a).

18. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Maurie Garcia Baker, Ph.D. whose telephone number is (703) 308-0065. The examiner can normally be reached on Monday-Thursday from 9:30 to 7:00 and alternate Fridays.

19. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph K. McKane, can be reached on (703) 308-4537. The fax phone number for the organization where this application or proceeding is assigned is (703) 308-4242. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0196.

Maurie Garcia Baker, Ph.D.  
August 8, 2002

  
**MAURIE E. GARCIA, PH.D.**  
**PATENT EXAMINER**